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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
BELLINGER, JASON R	

ART UNIT	PAPER NUMBER
3617	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/724,000	JENKINS ET AL.	
	Examiner	Art Unit	
	Jason R Bellinger	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-18* is/are pending in the application.

4a) Of the above claim(s) *16-18* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/30/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election without traverse of species I, drawn to figures 15A-15C in the reply filed on 14 February 2005 is acknowledged.

2. Claims 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 14 February 2005.

Claim Objections

3. Claim 7 is objected to because of the following informalities: The term --said-- should be inserted prior to the term "slot" in line 1 of the claim for grammatical clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 6-8, 10-12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Merriman. In Figures XI through XIII, Merriman shows a vehicle wheel weight having a mass portion 42 formed of a non-lead material, namely steel (see

column 3, lines 19-21). The mass portion 42 includes a first side for juxtaposition against a wheel rim 66 and an opposite second side. The mass portion 42 further defines a clip attachment slot (formed when the mass portion 42 is folded along line 44).

A spring clip 62 includes an extended portion for engaging the wheel rim 66, and an attachment portion 56 inserted into and retained in the slot, so that the spring clip 62 is attached to the mass portion 42. The slot is closed against the attachment portion 56 of the spring clip 62 to attach the spring clip 62 to the mass portion 42. The attachment portion 56 of the spring clip 62 includes at least one surface irregularity (see Figure XIII, and comparative Figure IV) to facilitate retention of the attachment portion 56 in the slot.

The slot extends along the entire axial length of the mass portion 42, and has a generally V-shaped configuration before attachment of the spring clip 62 (see comparative Figure II). The spring clip 62 has a generally C-shaped configuration.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> **(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.**

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman. Merriman contains all of the limitations as set forth in paragraph 5 above, but does not specify that the mass portion is formed from low carbon steel. However, one of

ordinary skill in the art at the time of the invention would have found it obvious to use any type of steel to form the mass portion of the wheel weight, dependent upon the physical and chemical properties required for the weight, availability of such material, and cost.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman as applied to claims 6-8, 10-12, and 14-15 above, and further in view of Brown. Merriman does not show the surface irregularity of the spring clip being at least one hole defined through the attachment portion.

Brown teaches the use of a balance weight having a spring clip 28 having at least one hole 20 defined through an attachment portion 20. Therefore from this teaching, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the attachment portion of the spring clip of Merriman with through holes as a substitution of equivalent irregularities, for the purpose of increasing the securing interaction between the mass portion of the weight and the attachment portion of the spring clip, thus preventing the clip from being removed from the weight.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman as applied to claims 6-8, 10-12, and 14-15 above, and further in view of Maruyama et al. Merriman does not disclose that the mass portion is formed of iron.

Maruyama et al teaches the use of a wheel weight 1 that is formed of a mass of iron. Therefore from this teaching, it would have been obvious to one of ordinary skill in

the art at the time of the invention to form the mass portion of Merriman from iron as an equivalent substitution for lead, in order to reduce environmental contamination and/or health issues due to the use of lead wheel weights.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 6, 12, and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 & 23, 13, and 21 & 24, respectively of copending Application No. 10/620,309. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims contain all of the limitations of the copending claims. Therefore, it is obvious that the same invention is being claimed in different terms.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references are considered to show wheel weights having a spring clip embedded in a mass portion. For example, Morne shows a wheel weight of the type described above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason R Bellinger whose telephone number is 703-308-6298. The examiner can normally be reached on Mon - Thurs (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason R Bellinger
Examiner
Art Unit 3617

JASON R. BELLINGER
PATENT EXAMINER

jrb

3/5/05